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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,583	12/21/2001	Subraman Rao Cherukuri	24734	2492

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WASHINGTON, DC 20005

EXAMINER

COE, SUSAN D

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 02/21/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/024,583

Applicant(s)

CHERUKURI ET AL.

Examiner

Susan Coe

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1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 36 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-39 are currently pending.

#### *Election/Restrictions*

2. Applicant's election with traverse of Group I, claims 1-35, 38, and 39; hydrogenated starch hydrolysate and lactitol for species A, partially hydrogenated soybean oil for species B, lecithin for species C, dietary fibers for species D, carrageenan for species E, hydroxypropylmethyl cellulose for species F, and psyllium for species G in Paper No. 5, dated January 29, 2003, is acknowledged. The traversal is on the ground(s) that the product cannot be made by a different process. This is not found persuasive because the prior art teaches a composition that has the same ingredients as applicant's composition but is not made by a process that meets all of the limitations of the claims of Group II (see column 13, lines 40-53 of US Pat. No. 4,963,359).

Applicants also argue that a search of all both of the groups would not be burdensome because both of the groups are classified in the same class and subclass and because the examiner can use "electronic search engines...to quickly and easily search all of the claims...". However, a search of both groups would not necessarily be coextensive as evidenced by US Pat. No. 4,963,359. The searches do overlap in regards to the classification, but when performing the electronic search, different searches would be required that are not considered to be "quick and easy," and would in fact be time consuming and burdensome.

Applicant also argues that excessive fees are required. However, since this restriction requirement is considered valid for the reasons stated above, the fees are not considered

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excessive because applicant can only claim one invention per application (see MPEP section 800).

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 36 and 37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-27, 29-35, 38, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4,963,359.

US '359 teaches a sugar free composition that contains hydrogenated starch hydrolysates, fats, and emulsifiers. A humectant such as sorbitol or glycerin (see column 10, lines 47-52), water, and medicaments are also included in the composition. These ingredients can be present in a variety of amounts that meet the limitations of applicant's claims (see claims). The reference specifies that the emulsifier can be lecithin (see column 10, line 7). The fat can be partially hydrogenated vegetable oils (see column 9, lines 23-39). The emulsifier mixes with the fat to form the emulsion (see column 10, lines 10-15). The composition can also includes gelatin, carrageenan, gums, and psyllium (see paragraph spanning pages 10 and 11). The

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composition can be peppermint, menthol, chocolate, cinnamon, spearmint, vanilla, or fruit flavored (see column 10, lines 35-38).

*Claim Rejections - 35 USC § 103*

5. Claims 1-35, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4,963,359.

As discussed above, the reference is considered to teach applicant's composition. However, the references does not specifically teach adding the ingredients in all of the amounts claimed by applicant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.

In addition, the reference does not specifically teach using lactitol in the composition. However, the reference does teach using sugar alcohols in the composition as humectants (see column 10, line 51). Since lactitol is a known sugar alcohol, a person of ordinary skill in the art would reasonably expect that it could be used as a humectant. Thus, an artisan of ordinary skill would have been motivated to use lactitol in the composition taught by US '359.

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The reference also does not specifically teach using partially hydrogenated soybean oil in the composition. However, the reference does teach using partially hydrogenated vegetable oil in the composition (see column 9, lines 23-29). Since partially hydrogenated soybean oil is a known edible vegetable oil, a person of ordinary skill in the art would reasonably expect that it could be used as the edible oil. Thus, an artisan of ordinary skill would have been motivated to use partially hydrogenated soybean oil in the composition taught by US '359.

The reference also does not specifically teach using all of the flavorants claimed by applicant. However, all of the flavors claimed are well known flavors for foods; therefore, a person of ordinary skill in the art would be motivated to used these flavors in the composition taught by the reference.

6. Claims 1-35, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4,911,937.

US '937 teaches a nougat composition that contains hydrogenated starch hydrolysates, whipping agents, thickening agents, cellulose, water, sugar alcohols, fats, flavorings, and colors (see column 11, line 56 - column 12, line 18). The whipping agent can be gelatin (see column 9, line 12). The fat can be soy oil (see column 9, line 58). The sugar alcohol can be lactitol (see column 11, line 27). The thickening agent can be carrageenan or psyllium (see column 13, lines 48 and 50). The cellulosic can be hydroxypropylmethyl cellulose (see column 14, lines 56 and 57). The composition can have many different flavorings (see column 10). The nougat composition can also contain lecithin (see column 7, lines 55-57 and Table 3).

The references does not specifically teach adding the ingredients in the amounts claimed by applicant. The amount of a specific ingredient in a composition is clearly a result effective

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parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.


7. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Susan Coe, Examiner  
February 13, 2003

  
LEON B. LANKFORD, JR.  
PRIMARY EXAMINER